

No. 87-1241

Supreme Court, U.S.

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IN THE  
Supreme Court of the United States

OCTOBER TERM, 1987

COMMONWEALTH OF PENNSYLVANIA,  
*Petitioner,*  
v.

UNION GAS COMPANY,  
*Respondent.*

ON WRIT OF CERTIORARI TO THE  
UNITED STATES COURT OF APPEALS FOR  
THE THIRD CIRCUIT

BRIEF *AMICI CURIAE* OF  
THE ASSOCIATION OF AMERICAN PUBLISHERS, INC.  
AND THE ASSOCIATION OF  
AMERICAN UNIVERSITY PRESSES, INC.  
IN SUPPORT OF RESPONDENT

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IN SUPPORT OF RESPONDENT**

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The Association of American Publishers, Inc. ("AAP") and the Association of American University Presses, Inc. ("AAUP") respectfully submit this brief *amici curiae* in support of Respondent. By writings filed with the clerk, Petitioner and Respondent have consented to the filing of this brief.

**INTEREST OF *AMICI CURIAE***

AAP is a trade association of book publishers. Its approximately 300 members publish between 70% and 75% of the dollar volume of all books published in the United States. Its members' publications include text, technical and reference books, as well as works of fiction and general non-fiction.

The Association of American University Presses, Inc. is a not-for-profit association of university presses. Its 80 members include the presses of virtually every distinguished university in the United States, as well as several Canadian and international scholarly publishers.

*Amici*, as well as copyright owners generally, have a direct and compelling interest in the question presented in this case concerning the extent of congressional power to abrogate Eleventh Amendment immunity. Their livelihood depends in large part on widespread observance of the property rights guaranteed by § 106 of the Copyright Act, and on the availability of judicial relief from violations of these rights. AAP and AAUP members market their copyrighted works to states and state entities, and protection of the rights granted to them by Congress depends in large measure on their ability to require these customers to comply with the copyright laws equally with other customers in the private market. Some recent cases construing the Eleventh Amendment, which threaten to effectively exempt states from the copyright laws, together with assertions by the Attorneys General of several states that appear to claim broad immunity for state entities from liability for copyright infringement, have endangered these rights.

AAP and AAUP have no expertise concerning "Superfund" issues and this brief does not discuss them. It focuses exclusively on the power of the Congress to abrogate Eleventh Amendment immunity under Article I of the Constitution. That power is vital to maintaining an important marketplace for copyrighted works.

### SUMMARY OF ARGUMENT

Congress has the power to abrogate states' Eleventh Amendment immunity whenever it enacts legislation under its plenary authority, including the authority found in such diverse provisions of Article I of the Constitution as those covering interstate commerce, bankruptcy, and copyright matters. This Court has never held otherwise. A decision to do so here would not only deprive Respondent of a federal forum for seeking relief from Petitioner in the instant controversy. It might

deprive copyright owners of *any* forum in which to seek effective relief for copyright infringement from states and state entities.

### ARGUMENT

#### ARTICLE I OF THE CONSTITUTION EMPOWERS CONGRESS TO ABROGATE THE STATES' IMMUNITY TO SUITS FOR DAMAGES IN FEDERAL COURTS

In most Eleventh Amendment cases, "the issue is not the general immunity of the States from private suit . . . but merely the susceptibility of the States to suit before *federal tribunals*." *Atascadero State Hosp. v. Scanlon*, 473 U.S. 234, 240 n.2 (1985) (emphasis in original) (quoting *Employees v. Missouri Dep't of Public Health and Welfare*, 411 U.S. 279, 293-94 (1973) (Marshall, J., concurring in result)). Thus, wherever the Eleventh Amendment has been found to preclude federal court jurisdiction, some other forum has been available. See, e.g., *Atascadero*, 473 U.S. at 240 n.2 ("It denigrates the judges who serve on the State courts to suggest that they will not enforce the supreme law of the land"); *Pennhurst State School and Hosp. v. Halderman*, 465 U.S. 89, 121-23 (1984) (requiring pendent state law claims to be brought in state court); *Welch v. State Dep't of Highways*, 107 S.Ct. 2941, 2953 n.19 (1987) (worker's compensation claim could be pursued in state court).

In these previously decided Eleventh Amendment cases, plaintiffs could have sought relief in state courts. There is, however, an important class of potential plaintiffs for whom a holding that Congress could not, under its Article I powers, abrogate Eleventh Amendment immunity, would be devastating. This class comprises the publishers represented by *amici*, as well as others—authors, artists, playwrights, filmmakers, composers, computer programmers, and more—of this country's creative community. As copyright owners, they may seek judicial relief *only* in federal courts, where exclusive

jurisdiction over infringement actions lies.<sup>1</sup> AAP and AAUP members, for example, do substantial business with state entities.<sup>2</sup> Indeed, some specialized publishers may do the majority of their business with entities having potential Eleventh Amendment immunity. If the Eleventh Amendment closes the federal courthouse door to them, then states would be free to ignore the carefully crafted balance created by the copyright law, 17 U.S.C. §§ 101 *et seq.*<sup>3</sup>

Until relatively recently, very few copyright cases had involved Eleventh Amendment issues. The only two cases concerning the Copyright Act of 1909 were split on the question of immunity. In *Wihtol v. Crow*, 309 F.2d 777 (8th Cir. 1962), the court held a school system immune from liability for a teacher's infringing duplication of a musical work, while in *Mills Music, Inc. v. Arizona*, 591 F.2d 1278 (9th Cir. 1979), the

<sup>1</sup> 28 U.S.C. § 1338(a) (1982). The Copyright Act, by preempting state laws that might otherwise cover copyright infringing activities, 17 U.S.C. § 301 (1982), precludes any possibility that copyright owners might seek relief from state entities on state law grounds in state courts. *Cf. Welch*, 107 S.Ct. 2941, where a state law remedy was potentially available.

<sup>2</sup> AAP estimates that, in 1986, U.S. book publishers sold \$1.1 billion worth of college and university textbooks to customers with potential Eleventh Amendment immunity who might well not be liable for damages should they choose to copy rather than purchase such materials. See generally, Register of Copyrights, *Copyright Liability of States and the Eleventh Amendment* 5-17 (1988).

<sup>3</sup> While under Eleventh Amendment doctrine some manner of injunctive relief may be available, Congress could not have considered injunctions alone to be an adequate remedy for copyright infringement. By their nature, injunctions can merely "forestall future violations." *United States v. Oregon State Medical Society*, 343 U.S. 326, 333 (1952). Injunctions, unlike damages, do not provide any degree of recompense to aggrieved copyright owners for infringements that have already occurred, or for markets that have been substantially eroded, if not destroyed. Nor are they available without a likelihood of repeated harm by the infringing party. A limitation to injunctive relief would eliminate any real possibility of favorable settlement for copyright owners and would permit the continuation of infringing activity by great numbers of entities, until in each separate case the particular infringement happens to be detected and an injunction obtained. Moreover, it should be noted that copyright infringement, for example, of computer software, or by photocopying, is particularly unsuceptible to detection as compared to most wrongs traditionally remedied by injunctive relief. Injunctive relief is thus likely to be even less effective in forestalling serious harm than usual.

court held a state liable for the unauthorized public performance of music.

In the last several years, however, additional courts have accorded Eleventh Amendment immunity in copyright cases.<sup>4</sup> And at least one of these courts has suggested that not only has Congress not acted to abrogate state immunity, but that Congress has no power to do so, notwithstanding the plenary congressional copyright power under Article I.<sup>5</sup>

AAP and AAUP have, together with other copyright owners, filed briefs *amici curiae* in the Courts of Appeals for the Fourth and Ninth Circuits,<sup>6</sup> urging that Congress, in enacting the copyright law, met the "unmistakable clarity" standard set out in *Atascadero*, 473 U.S. at 242, and *Welch*, 107 S. Ct. at 2948, if, indeed, that standard is applicable in copyright cases. *Amici* have argued, and necessarily, that Congress has the power, under Article I of the Constitution, to abrogate Eleventh Amendment immunity. This court has suggested that such power exists, and, as set out below, several courts of appeals have expressly reached this conclusion.

One of the "certain exceptions to the reach of the Eleventh Amendment," *Welch*, 107 S. Ct. at 2945, arises when Congress, pursuant to its plenary power, provides for a cause of action in federal court against the States:

Because of the Eleventh Amendment, States may not be sued in federal court unless they consent to it in

<sup>4</sup> *Cardinal Indus. v. Anderson Parrish*, No. 83-1083-Civ-T-13 (M.D. Fla. Sept. 6, 1985), *aff'd* 811 F.2d 609 (11th Cir.), *cert. denied*, 108 S.Ct. 88 (1987); *BV Engineering v. UCLA*, 657 F.Supp. 1246 (C.D. Cal. 1987); *Richard Anderson Photography v. Radford Univ.*, 633 F.Supp. 1154 (W.D. Va. 1986); *Woelffer v. Happy States of America, Inc.*, 626 F.Supp. 499 (N.D. Ill. 1985); and *Mihalek Corp. v. Michigan*, 595 F.Supp. 903 (E.D. Mich. 1984), *aff'd on other grounds*, 814 F.2d 290 (6th Cir.), *cert. denied* 108 S.Ct. 503 (1987). *Contra, Johnson v. University of Va.*, 606 F.Supp. 321 (W.D. Va. 1985).

<sup>5</sup> See, *Richard Anderson Photography*, 633 F.Supp. 1154 (W.D. Va. 1986).

<sup>6</sup> *Richard Anderson Photography v. Radford Univ.*, 633 F.Supp. 1154 (W.D. Va. 1986), *appeal docketed*, No. 87-1610 (4th Cir. 1987); *BV Engineering v. UCLA*, 657 F.Supp. 1246 (C.D. Cal. 1987), *appeal docketed*, No. 87-5920 (9th Cir. 1987).

unequivocal terms or unless Congress, pursuant to a valid exercise of power, unequivocally expresses its intent to abrogate the immunity.

*Green v. Mansour*, 474 U.S. 64, 68 (1985) (emphasis added). The Copyright Act was enacted pursuant to a direct constitutional grant of power, the Copyright and Patent Clause, Art. I, § 8, cl. 8. That constitutional source fully empowers Congress to abrogate the states' Eleventh Amendment immunity with respect to copyright, and to subject state entities—in common with all other alleged copyright infringers—to damage suits in federal court.

There is no basis to doubt that Congress can rely on any of its powers (including those in Article I) to subject states to suit in federal court on federal causes of action. In *Green v. Mansour*, this Court did not limit congressional power to the Fourteenth Amendment, but broadly declared that Congress may abrogate state immunity "pursuant to a valid exercise of power." *Id.* In two other cases, this Court has assumed, without expressly deciding, that Congress may abrogate state immunity under Article I. *Welch*, 107 S.Ct. at 2946; *County of Oneida v. Oneida Indian Nation*, 470 U.S. 226, 252-53 (1985).

No persuasive rationale exists to support congressional power to abrogate state immunity when it acts under Section 5 of the Fourteenth Amendment—a power expressly recognized in *Fitzpatrick v. Bitzer*, 427 U.S. 445 (1976)—but not when it acts under its other plenary powers. In *Welch*, the Court set forth persuasive reasoning for concluding that Congress does have authority to abrogate a state's immunity to suit in federal court under its Article I powers:

By ratifying the Constitution, the argument runs, the States necessarily consented to suit in federal court with respect to enactments under [a Constitutional Clause authorizing Congressional regulation].

107 S.Ct. at 2947 n.5.

This rationale has been adopted by the court below and by other courts of appeals considering the issue, which have concluded that there is no constitutionally significant way to

distinguish Congress' Fourteenth Amendment power from any of its Article I powers. See *In re McVey Trucking, Inc.*, 812 F.2d 311, 314-23 (7th Cir.), *cert. denied*, 108 S.Ct. 227 (1987) (discussing *Atascadero* and its predecessors, and concluding, after extensive analysis, that the various Congressional plenary powers cannot be distinguished); *In re Vazquez, Guerrero and Compton*, 788 F.2d 130, 132 (3d Cir.), *cert. denied*, 107 S.Ct. 414 (1986) (abrogation of Eleventh Amendment immunity under Bankruptcy Clause); *Mills Music, Inc. v. Arizona*, 591 F.2d 1278, 1285 (9th Cir. 1979) ("[T]he Copyright and Patent Clause is a specific grant of constitutional power that contains inherent limitations on state sovereignty. . . . [I]t is clear that the abrogation of a state's Eleventh Amendment immunity is inherent in the Copyright and Patent Clause and the Copyright Act"); *Peel v. Florida Dep't of Transp.*, 600 F.2d 1070, 1080-81 (5th Cir. 1979) (Congress may abrogate state immunity in an act passed pursuant to the war powers in Art. I, § 8). Of like effect, although not concerned with Article I, is *County of Monroe v. Florida*, 678 F.2d 1124, 1132 n.8, 1133 (2d Cir. 1982), *cert. denied*, 459 U.S. 1104 (1983) (Congress may, pursuant to Art. IV, § 2, cl. 2, abrogate state immunity from suit on extradition-related claims).

Recognition of Congress' power to abrogate Eleventh Amendment immunity under Article I is particularly essential if the statutory balance between copyright owners and users of their works is to be maintained. Recent copyright litigation and other claims of Eleventh Amendment immunity in the copyright context<sup>7</sup> reflect assertions that states are substantially beyond the reach of the copyright law. A decision holding Congress unable to abrogate state immunity under its Article I powers could affect not only the whole panoply of commerce clause issues but also the property rights of *amici* and all copyright owners.

<sup>7</sup> In a recent congressionally requested inquiry, the Copyright Office of the Library of Congress noted that, in addition to the five states asserting Eleventh Amendment copyright immunity in the cases cited in n.4, *supra* (Virginia, California, Florida, Michigan and Illinois), North Carolina, Wisconsin, Massachusetts, Minnesota, and Texas have asserted their immunity in other contexts. Register of Copyrights, *Copyright Liability of States and the Eleventh Amendment* 8, 9, app. C at CRS-21 (1988).

**CONCLUSION**

For the foregoing reasons, the decision of the court of appeals holding that Congress may abrogate Eleventh Amendment immunity under its Article I powers should be affirmed.

Respectfully submitted,

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